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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re HEB Grocery Company, LP

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Serial No. 76354346

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Kirt S. O'Neil of Akin Gump Strauss Hauer & Feld LLP for HEB Grocery Company, LP.

Samuel E. Sharper, Jr., Trademark Examining Attorney, Law Office 108 (David E. Shallant, Managing Attorney).

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Before Quinn, Bottorff, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

HEB Grocery Company, LP (applicant) applied to register the mark SNACK BITES, in typed form, on the Principal Register for goods ultimately identified as follows: "packaged serving consisting primarily of meat, cheese, vegetables and fruits" in International Class 29 and "packaged serving consisting primarily of crackers, cookies and bagels" in International Class 30. The

application (Serial No. 76354346 filed January 2, 2002) was based on applicant's allegation of its bona fide intention to use the mark in commerce.

The examining attorney refused to register applicant's mark on the ground that the mark would be merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), if it were used with applicant's goods. The examining attorney's position (Brief at 5) is that applicant's "words have a clear, unequivocal meaning, and, as they appear combined in applicant's mark, those words describe unequivocally, snack bites, i.e., snack consisting of food eaten between meals, which are bites sizes, a mouthful. There is nothing left for speculation, conjecture or imagination concerning applicant's mark."

Applicant's position (Brief at 6) is that:

> Applicant's mark which consists of definable terms has a unique connotation. For example, other definitions provided by the Trademark Examining Attorney suggest that BITES may refer to having a "stinging effect." When the term BITES is used in connection with SNACK, such combination may employ a unique commercial impression that is not descriptive of Applicant's goods. [An]other definition provided by the Trademark Examining Attorney suggests that the term BITES refers to bait. The combination of terms would possibly indicate that Applicant's goods are used for fishing. In fact, consumers may possibly view Applicant's mark as SNAKE BITES which would further ensure a finding that Applicant's mark is not merely descriptive.

Our principal reviewing court in In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) recently discussed the issue of when a mark is merely descriptive.

> A mark is merely descriptive if it immediately conveys information concerning a quality or characteristic of the product or service. [In re Nett Designs, 236 F.3d 1297, 1341, 57 USPQ2d 1564 (Fed. Cir. 1999)]. The perception of the relevant purchasing public sets the standard for determining descriptiveness. *Id*. Thus, a mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service. On the other hand, "if a mark requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods [or services], then the mark is suggestive." *Id*.

Inasmuch as we must view the mark in relationship to applicant's goods or services, the fact that in the abstract people may guess that applicant's mark may refer to a "stinging effect" or to fishing bait is irrelevant. Viewed in the context of applicant's goods, potential consumers of applicant's snack items would not reach such conclusions. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) ("Appellant's abstract test is deficient – not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute").

The following evidence is relevant in determining what prospective purchasers would understand the term SNACK BITES to mean if it were used on packaged servings consisting of various food items. The examining attorney has submitted definitions of "snack" as "a hurried or light meal" and "food eaten between meals." See Office Action dated April 15, 2002 at 2-3.[1] Regarding the term "bites," one definition that the examining attorney included is: "an amount of food taken into the mouth at one time; a mouthful." Id. In addition, the examining attorney has submitted numerous registrations that show that the term "bites" has been disclaimed for various food items or registered under the provision of Section 2(f) or on the Supplemental Register.[2] See, e.g., Registration Nos. 2,718,171 (PRO BITES, "Bites" disclaimed, for high protein, low carbohydrate soy based snack foods); 2,690,963 (ORIEN BITES, "Bites" disclaimed, for fish balls, calamari balls, seafood wantons, seafood dumplings, etc.); 2,614,158 (YO BITES, "Bites" disclaimed, for fresh prepackaged sliced fruit); 2,600,371 (BELLA BITES, "Bites" disclaimed, for processed portabella mushrooms); 2,425,543 (MORNING BITES,

[1] Applicant has offered a disclaimer of the term "snack." See Response dated October 15, 2002 at 2.

[2] When we discuss these registrations, we will refer to the registrations that the examining attorney submitted with his final refusal.

"Bites" disclaimed, for packaged, snack-sized egg-based product with and without fillings and other ingredients, wrapped in dough); 2,141,436 (WILD BITES, "Bites" disclaimed, for beef jerky); 2,111,615 (YUM BITES, "Bites" disclaimed, for cheese sandwich snacks and chocolate sandwich snacks); 2,358,304 (BORDER BITES, "Bites" disclaimed, for tacos, chimichangas, taquitos, empanadas, and egg rolls); 2,643,658 (HOT BITES, Section 2(f), for frozen bagel or dough based snacks with or without cheese and/or with or without toppings); and 2,333,968 (GOLDEN BITES, Supplemental Register, for prepared potatoes). These registrations indicate that the term "Bites" would have a descriptive meaning when used on various food items. General Mills Inc. v. Health Valley Foods, 24 USPQ2d 1270, 1277 (TTAB 1992) ("Although the registrations are not evidence of use, the registrations show the sense in which the term 'fiber' is employed in the marketplace, similar to a dictionary definition"). Finally, the examining attorney also included two Internet printouts that show use of the term "Bites" descriptively. See www.cattaneobros.com ("Snack Bites are the ends and pieces of our Smoked Beef Sticks. Not only are they easy to chew, but they are bite-sized"); www.seriousprofits.net ("'Snack Bites'" – "A bite-sized, high quality, quick 'pick-me-up,' offering a

filling, highly nutritious snack, that keeps energy up and the diet suppressed for up to six hours").

This evidence shows that both the terms "snack" and "bites" would have a descriptive meaning when applied to applicant's packaged servings of various food items. We note that applicant submitted "sample artwork of packaging for similar goods sold under Applicant's mark 'LUNCH BITES' and 'CREATE-A-CRACKER.'" Response dated February 20, 2003 at 1. This material includes the question: "When is the right time for Lunch Bites?" To which the answer is "Lunchtime, Snacktime, Anytime!" The package indicates that the contents of the package include ham, cheese, and crackers. When prospective purchasers view the term SNACK BITES in relation to applicant's packaged servings of various food items, they would understand the terms "snack" and "bites" describe applicant's snack food items that are bite sized.[3]

[3] Applicant argues (Brief at 5 n.1) that its "goods are not restricted to consumption between meals." Obviously, its goods would include food for eating between meals or snack food. A term is merely descriptive of goods and services even if it is not descriptive of every aspect of the goods or services. In re Pencils, Inc., 9 USPQ2d 1410, 1411 (TTAB 1988) ("While applicant's stores may carry a variety of products, pencils are one of those products, and, thus, the term 'pencils' is merely descriptive as applied to retail stationery and office supply services").

We must obviously consider the mark as a whole in determining whether the mark is merely descriptive because, even if the individual terms are descriptive, the mark as a whole may not be. However, in this case, we cannot agree with applicant that the combined term is suggestive. Again, applicant's goods would be snacks that are small size or bite size. Applicant's argument that potential customers would rely on an alternative definition of "bite" as "a light meal or snack" to translate the mark to mean SNACK SNACKS is unpersuasive. First, there is no per se rule that simply repeating a descriptive or generic term changes the term into a suggestive term. Second, the two registrations (Nos. 1,399,730 and 1,439,558) to which applicant refers are for the mark PIZZA!PIZZA! and both contain a disclaimer of the term "pizza." Third, it is highly unlikely that prospective purchasers would understand the term "bite," which has a common meaning for food items of small size, to be simply a redundant term for snacks. Fourth, if we were to assume that the '730 and '558 registrations were relevant, we note that even "if some prior registrations had some characteristics similar to [applicant's mark], the PTO's allowance of such prior registrations does not bind the Board or this court." In

re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Responding to applicant's last argument that applicant's combined term is unique, even if this were true, that fact would not change applicant's descriptive term into a suggestive one. In re Tekdyne Inc., 33 USPQ2d 1949, 1953 (TTAB 1994) ("The fact that applicant will, or intends to be, the first and/or only entity to use the term "MICRO-RETRACTOR" for surgical clamps is not dispositive where, as here, such term unequivocally projects a merely descriptive connotation").

When we consider the evidence of record, we agree with the examining attorney that the term SNACK BITES would describe applicant's packaged servings consisting primarily of meat, cheese, vegetables and fruits or crackers, cookies and bagels.

Decision: The refusal to register under Section 2(e)(1) of the Trademark Act is affirmed.